



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/875,530 | 06/06/2001 | Hisashi Tanaka | 14684 | 6951 |
| 23389 | 7590 | 08/10/2005 | EXAMINER | |
| SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530 | | | POND, ROBERT M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,530

Applicant(s)

TANAKA ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4,6,8-11,13-15,20-25,27-29 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 31 May 2005 has been entered.

Response to Amendment

The Applicant canceled claims 1, 7, 12, 18-19, and 26, and amended claims 2, 9, 13, 20, 23, 24, 27, and 37. All pending claims (2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37) were examined in this non-final office action.

Response to Arguments

Applicant's arguments filed 25 March 2005 have been fully considered but they are not persuasive. A customer registers customer information that is stored permanently in remote server storage whereby any subsequent access results in the server recognizing the customer in advance of subsequent purchases. A customer has the option of changing the customer information (e.g. does not agree with server's selection, contains an error). For example, the customer can

Art Unit: 3625

change the previously stored shipping address to enter a new shipping address.

The customer action is designating alternative pieces of information used to complete the purchase.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1. Claims 2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37 are rejected under 35 USC 102(e) as being anticipated by Boesch et al. (Paper #2, patent number 6,092,053 hereinafter referred to as “Boesch”).**

Boesch teaches all the limitations of Claims 2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37. For example, Boesch discloses a method of electronic commerce allowing consumers to purchase items over a network and merchants to receive payment information relating to the purchases (please see at least abstract; Fig. 1 (100, 102, 120, 122, 160); col. 2, line 10 through col. 4, line 62). Boesch further discloses:

- Storing customer information entered in a plurality of terminals; in advance: customer information is entered by each customer on respective

customer computer (see at least Fig. 1(100, 102, 104)); customer registering resulting in customer information being stored permanently in remote server storage; subsequent access results in server recognizing the customer, the customer already being known to the system in advance of subsequent accesses; customer information being, but not limited to: customer's name, billing address, shipping address, credit card number, email address, telephone numbers, fax numbers, and user preferences (see at least Fig. 1 (146); col. 5, lines 35-37; col. 6, lines 20-34).

- Designating a commodity provided by commodity provision means: merchant server, CIS, network (see at least col. 3, lines 20-54).
- Displaying the customer information: displays graphic of customer wallet on customer computer via web browser (see at least col. 3, lines 37-43).
- Designating by the user alternative pieces of information: customer has option of changing the customer's information (e.g. does not agree with server's selection, contains an error); customer can change the previously stored shipping address to enter a new shipping address; can have a plurality of possible entries (see at least col. 9, line 62 through col. 10, line 16). Please note: customer action is designating alternative pieces of information.
- Customer information pertaining to the designated commodity: e.g. credit card number, address, shipping address (see at least col. 3, lines 54-61).

Art Unit: 3625

- Storing; storage means: databases, data logs, data structures (see at least col. 3, lines 18-19; col. 12, lines 16-18).
- Modules: software, pages, forms (please note examiner's interpretation: pages and forms are examples of display modularity as executed by software) (see at least col. 3, line 62-65).

Pertaining to system claims 13-15, 20-25, 27-29, and 34-37

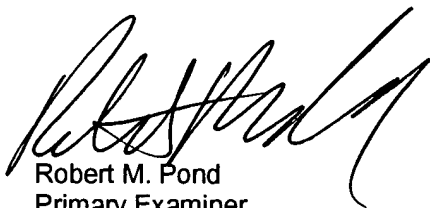
Rejection of claims 13-15, 20-25, 27-29, and 34-37 is based on the same rationale as noted above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
August 5, 2005